

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bosch et al.
Title: DRY POWDER AEROSOLS OF
NANOPARTICULATE DRUGS
Appl. No.: 09/190,138
Filing Date: 11/12/1998
Patent No.: 7,521,068 B2
Grant Date: 4/21/2009
Examiner: James Henry Alstrum Acevedo
Art Unit: 1616
Confirmation 6300
Number:

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 4/21/2009 as U.S. Patent No. 7,521,068 B2.

The Patent Office determined that the patent was entitled to 1095 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 1247 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1523 days
(b) Total Applicant delay:	276 days
Final PTA Determination:	1247 days

Applicants therefore respectfully request that the patent be accorded 1247 days PTA.

The patent is not subject to a terminal disclaimer.

Applicants would also like to point out that on December 18, 2008, the Examiner requested that Applicants delete the illustrations on pages 15, 17, and 21 of the specification and provide drawings/figures for these illustrations. At the Examiner's request, Applicants provided along with the Issue Fee payment on December 22, 2008, three (3) sheets of drawings. Therefore, Applicants should not be charged 120 days of PTA as indicated in the U.S. PTO's PTA calculation because this was done at the Examiner's request.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because these PTA errors are due to a Patent Office errors in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date: June 19, 2009

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Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 029318-0109

Application Number: 09/190138

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Continued Prosecution Application	06/05/2001	0		
Edit Delete	Non-Final Office Action	08/27/2001	83		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	11/27/2001	175		
Edit Delete	Final Office Action	02/11/2002	251		
	Final Office Action + 3 months	05/11/2002	340		
Edit Delete	Final Office Action Response Received at PTO	07/11/2002	401		
Edit Delete	Notice of Appeal Received at PTO	08/12/2002	433		93
Edit Delete	Advisory Action	08/15/2002	436		
Edit Delete	Request For Continued Examination	10/15/2002	497		
Edit Delete	Non-Final Office Action	12/24/2002	567		
	Non-Final Office Action + 3 months	03/24/2003	657		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	06/24/2003	749		92
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	10/24/2003	871		
CLOSE WINDOW	ALL CASES SELECT CASE				
Edit Delete	Final Office Action	01/14/2004	953	82	
	Final Office Action + 3 months	04/14/2004	1,044		
Edit Delete	Final Office Action Response Received at PTO	05/14/2004	1,074		
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Edit Delete	Advisory Action	07/22/2004	1,143		
Edit Delete	Appeal Brief Received at PTO	10/13/2004	1,226		
	Appeal Brief Filed + 4 months	02/13/2005	1,349		
Edit Delete	Examiner's Answer Mailed	05/26/2006	1,816	(467)	
Edit Delete	Reply Brief Received at PTO	07/25/2006	1,876		
Edit Delete	Examiner's Answer Mailed	09/27/2006	1,940		
Edit Delete	Appeal Decided by Appeal Board; Some Rejections Reversed	06/23/2008	2,575	1441	
Edit Delete	Notice of Allowance	09/24/2008	2,668		
Edit Delete	Issue Fee Paid	12/22/2008	2,757		

Edit Delete

Patent Grant Date

04/21/2009

2,877

Totals:

1,523

276

PTA:

1,247

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